

Appln. No. 10/076,587
Amendment dated May 11, 2004
Reply to Office Action mailed April 5, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 11 remain in this application.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 and 2 of the Office Action

Claims 1-11 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 1-11 is therefore respectfully requested.

Paragraphs 3 and 4 of the Office Action

Claims 1-3 and 7-9 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Abad et al. in view of Randall et al., Baioff et al. or Giordano et al.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

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In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

In regard to claim 1, it is submitted that the combination of Abad with Randall, Baioff or Giordano is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said apertures of said influent manifold being aligned with said apertures of said exfluent manifold to allow the urine bag to be in fluid communication with one of said apertures of said influent manifold and an associated one of said apertures of said exfluent manifold when the urine bag is coupled to said influent manifold and said exfluent manifold, each of said apertures of said influent manifold being in direct fluid communication with the associated one of said apertures of said exfluent manifold to allow the fluid to pass directly from said influent manifold to said exfluent manifold through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold". The Abad reference teaches a portable cleaning apparatus that fails to teach the apertures of the influent manifold being aligned with the apertures of the exfluent manifold so that each of the apertures of the influent manifold are in direct fluid communication with an associated one of the apertures of the exfluent manifold to permit the fluid to pass directly through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold as claimed by the applicant. The Randall reference teaches a cleaning apparatus that fails to teach the apertures of the influent manifold being aligned with the apertures of the exfluent manifold so that each of the apertures of the influent manifold are in direct fluid communication with an associated one of the apertures of the exfluent manifold to permit the fluid to pass directly through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold as claimed by the applicant. The Baioff reference teaches a cleaning apparatus for paint applicator heads

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that fails to teach the apertures of the influent manifold being aligned with the apertures of the exfluent manifold so that each of the apertures of the influent manifold are in direct fluid communication with an associated one of the apertures of the exfluent manifold to permit the fluid to pass directly through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold as claimed by the applicant. The Giordano reference teaches a device for cleaning medical instruments that fails to teach the apertures of the influent manifold being aligned with the apertures of the exfluent manifold so that each of the apertures of the influent manifold are in direct fluid communication with an associated one of the apertures of the exfluent manifold to permit the fluid to pass directly through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold as claimed by the applicant. Therefore, it is submitted that the combination of the Abad reference with the Randall, Baioff or Giordano references would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

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Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Claims 2, 3 and 7 through 9 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 3 and 7 through 9 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1-3 and 7-9 is therefore respectfully requested.

Paragraph 5 of the Office Action

Claims 4-6 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the applied prior art as applied to claim 1 above, and further in view of Lithander.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

In regard to claim 1, it is submitted that the combination of Abad with Randall, Baioff or Giordano and Lithander is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said apertures of said influent

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manifold being aligned with said apertures of said exfluent manifold to allow the urine bag to be in fluid communication with one of said apertures of said influent manifold and an associated one of said apertures of said exfluent manifold when the urine bag is coupled to said influent manifold and said exfluent manifold, each of said apertures of said influent manifold being in direct fluid communication with the associated one of said apertures of said exfluent manifold to allow the fluid to pass directly from said influent manifold to said exfluent manifold through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold". As discussed above, the Abad, Randall, Baioff and the Giordano references fail to teach the apertures of the influent manifold being aligned with the apertures of the exfluent manifold so that each of the apertures of the influent manifold are in direct fluid communication with an associated one of the apertures of the exfluent manifold to permit the fluid to pass directly through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold as claimed by the applicant. The Lithander reference teaches a apparatus for cleaning cylindrical components that fails to teach the apertures of the influent manifold being aligned with the apertures of the exfluent manifold so that each of the apertures of the influent manifold are in direct fluid communication with an associated one of the apertures of the exfluent manifold to permit the fluid to pass directly through the urine bag when the urine bag is coupled to the influent manifold and the exfluent manifold as claimed by the applicant. Therefore, it is submitted that the combination of the Abad reference with the Randall, Baioff or Giordano and Lithander references would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

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The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Claims 4 through 6 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 4 through 6 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 4-6 is therefore respectfully requested.

Paragraph 6 of the Office Action

Claim 11 has been indicated as being allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in the Office Action.

Claim 11 has been amended and is believed to be in condition for allowance.


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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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